

REMARKS

Applicants cancelled claims 1-44, 51-58, 63, 66-84, 86 and 88, amended claims 45 and 59, and added new claims 89-95. Claims 45-50, 59-65, 85, 87 and 89-95 are presented for examination.

The Examiner rejected claim 63 under 35 U.S.C. §112, second paragraph. Applicants cancelled claim 63 and added claim 89 to correct typographical errors that were present in claim 63 as filed. Applicants request reconsideration and withdrawal of this rejection.

The Examiner rejected 45-50, 59-65, 85 and 87 under §102(b) as being anticipated by Laine or under §103(a) as being unpatentable over Laine in combination with Kobayashi.¹

As amended, claims 45-50, 59-62, 64, 65, 85 and 87 cover compositions that are in the form of a solution capable of being deposited onto a biaxially textured surface or a single crystal surface and processed in less than about five hours to form a barium fluoride-containing coating that is a precursor for a superconductor film that has a thickness of at least about 0.5 micrometer, has a critical current density of at least about 1×10^6 Amperes per square centimeter, and includes a rare earth metal, an alkaline earth metal and copper.

Laine discloses methods of making tractable ceramic precursors. (Laine at Abstract). Nowhere does Laine disclose a composition that has the characteristics required by claims 45-50, 59-62, 64, 65, 85 and 87.

Nor is there any suggestion to modify Laine's compositions to provide the compositions covered by claims 45-50, 59-62, 64, 65, 85 and 87. According to Laine, his technology satisfies a certain need. (Id. col. 2, line 20-col. 3, line 61). Thus, after reading Laine, one skilled in the art would not have been motivated to modify Laine.

Even if one skilled in the art had somehow been motivated to modify Laine's method, one skilled in the art would not have considered the teachings of Kobayashi. Laine and Kobayashi disclose different methods of forming oxide superconductors. As is well known to those skilled in the art, different methods of forming oxide superconductors can generally

¹ Claim 63 was cancelled, so the rejection of this claim should be withdrawn.

involve very different compositions, and it is not simply a matter of mixing and matching compositions from different methods. Here, however, the Examiner makes the conclusory assertion that, because Kobayashi purports to disclose an advantage to including an amine in his composition, one skilled in the art would have been motivated to add an amine to the compositions used in Laine's method. But, the Examiner ignores the differences between the methods disclosed by Laine and Kobayashi, and therefore does not properly provide an appropriate factual basis for the asserted motivation to combine the teachings of Kobayashi with Laine.

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection of claims 45-50, 59-62, 64, 65, 85 and 87 based on Laine, alone or in combination with Kobayashi.

The Examiner rejected claims 45 and 48 under §102(b) as being anticipated by Kobayashi. But, Kobayashi does not disclose a composition having the characteristics required by claims 45 and 48. Applicants therefore request reconsideration and withdrawal of the rejection of claims 45 and 48 based on Kobayashi.

The Examiner rejected claims 59-62 under §102(b) as being anticipated by Kimura. However, Kimura does not disclose a composition having the characteristics required by claims 59-62. Thus, Applicants request reconsideration and withdrawal of the rejection of claims 59-62 based on Kimura.

In view of Applicants arguments, the Examiner may wish to maintain one or more of the 35 U.S.C. §102 rejections based on an inherent anticipation argument. However, Applicants remind the Examiner that the standard for establishing that a reference inherently discloses particular subject matter is demanding. For example, as the United States Court of Appeals for the Federal Circuit ruled in Electro Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994):

The mere fact that a thing *may result* from a given set of circumstances is insufficient to prove anticipation. (citations omitted; emphasis original).

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Rather, one asserting that a reference inherently discloses certain subject matter must prove that the features are:

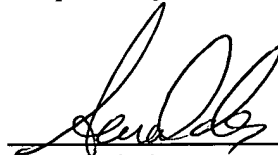
necessarily present [in the prior art reference] and that it would be so recognized by persons of ordinary skill. (Id.).

Applicants believe that it would be improper to reject the pending claims based on one or more of the cited references using an inherent anticipation rejection.

Applicants believe the application is in condition for allowance, which action is requested. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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